

173  
Thomas Schneck  
David M. Schneck  
Gina McCarthy  
Nissa M. Strottman

Of counsel:  
Boris G. Tankhilevich



Law Offices of  
**SCHNECK & SCHNECK**

P.O. BOX 2-E  
SAN JOSE, CALIFORNIA 95109-0005

80 S. Market Street  
Third Floor  
San Jose, California 95113-2303

Email: [webmail@patentvalley.com](mailto:webmail@patentvalley.com)

Patents and Trademarks

March 1, 2004

APF \$  
2878  
Telephone: (408) 297-9733

Facsimile: (408) 297-9748

**RECEIVED**

**MAR 09 2004**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Reply Brief of  
Applicant: R. Daniel McGrath et al.  
Serial No.: 09/872,209  
Filed: June 1, 2001  
For: DUAL-MODE CMOS INTEGRATED IMAGER  
HAVING USER INTERFACE (as amended)  
Our ref: ATM-181

Sir or Madam:

Applicant in the above-referenced patent application submits a Reply Brief to the Examiner's Answer of December 30, 2003. Also enclosed is a Request for Oral Hearing, with a check in the amount of \$290.00 for the fee for this service.

You are authorized to charge any additional required fee for the above services, or credit any refund, to Deposit Account No. 19-0590.

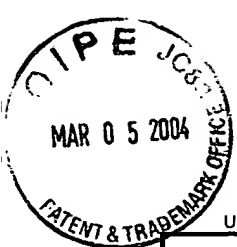
Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Thomas Schneck".

Thomas Schneck

TS/MP:sa

Encl: Reply Brief  
Check



RECEIVED

MAR 09 2004

PTO/SB/32 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REQUEST FOR ORAL HEARING BEFORE  
THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional)

ATM-181

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450"

on March 1, 2004Signature Sally AzevedoTyped or printed name Sally Azevedo

In re Application of

R. Daniel McGrath et al.

Application Number

09/872,209

Filed

6/1/2001

For

DUAL-MODE CMOS INTEGRATED IMAGER  
HAVING USER INTERFACE (as amended)

Art Unit

2878

Examiner

S.K. Yam

Applicant hereby requests an oral hearing before the Board of Patent Appeals and Interferences from in the appeal of the above-identified application.

The fee for this Request for Oral Hearing is (37 CFR 1.17(d))

\$ 290.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ \_\_\_\_\_

☒ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-0590. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(b) (PTO/SB/23) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 24,518

☐ attorney or agent acting under 37 CFR 1.34(a).  
Registration number if acting under 37 CFR 1.34(a) \_\_\_\_\_

Thomas Schneck  
Signature

Thomas Schneck

Typed or printed name

408/297-9733

Telephone number

March 1, 2004

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.194(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

03/09/2004 AWONDAF1 00000063 09872209

01 FC:1403

290.00 0P

RECEIVED

MAR 09 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Applicant: R. Daniel McGrath et al.      PATENT APPLICATION  
Serial No.: 09/872,209      Group Art Unit: 2878  
Filed: June 1, 2001      Examiner: S.K. Yam  
For: DUAL-MODE CMOS INTEGRATED IMAGER HAVING  
USER INTERFACE (as amended)

Applicant's - Appellant's

Reply Brief

37 CFR § 1.193(b)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: R. Daniel McGrath et al.      PATENT APPLICATION  
Serial No.: 09/872,209      Group Art Unit: 2878  
Filed: June 1, 2001      Examiner: S.K. Yam  
For: DUAL-MODE CMOS INTEGRATED IMAGER HAVING  
USER INTERFACE (as amended)

Reply Brief

This brief is submitted in response to new (or rephrased) arguments in the Examiner's answer, Response to Argument. The Examiner argues that "since the imager operates in the preliminary mode to provide low-resolution readout and intermittent operations (see col. 4, lines 40-43), it is fully functional to provide imaging data and provide working operation of the system" (pp. 5-6).

Applicant stands by the argument on pages 6-8 of the brief that the preliminary mode of Shinohara is insufficient without main operation of the microprocessor, both the preliminary and main operation being essential for a complete imaging operation. In any case, the timing for either preliminary or main operation of the imaging system is not a user selected mode. Even in preliminary mode, the specific timing is

always through internal clock generator 7, while in main operation the specific timing is always through microcomputer 2 and external line 6, there is no user mode selection. Claim 1 recites a user interface "configured to receive from a user a mode signal for setting the system in one of a first operating mode or a second operating mode..." (emphasis added)

Also in the answer (p. 6), with respect to the rejection of claims 1-6, the Examiner noted that Noble is used as secondary reference to provide teachings of "user control of a system clock frequency" compared to automatic control of the clock frequency in Shinohara, whereby "a user determines the optimal trade-off between power consumption and performance." Moreover, with respect to Applicant's arguments against the rejection of claims 7-9, the Examiner asserts (pp. 6-7) that "providing user control of an operation of imaging displays, especially to affect power consumption in a portable environment, is well known in the art" and that such a motivation can be applied to Shinohara's device.

However, the present claimed invention has to do with the imaging chip's ability to act as a stand-alone imager, if desired, and not with trade-offs between power consumption and performance. In the invention, the user mode determines whether timing is obtained from an internal (on-chip) element or received externally. Note that in claim 1, that "the first operating mode uses the internal timing element to control timing of the system and the second operating mode bypasses the internal timing element to control timing of the system." (emphasis added) The difference between the modes does not relate to changes in clock frequency, power consumption or performance, but from where the

clock is obtained. Likewise, in claim 7, the user interface allows "selection of the onboard timing means or outboard logic circuit", again referring to the source of the clock signals. Therefore, the user control does not relate to details of an external clock or control of the clock frequency as such.

# I. Conclusion

In conclusion, the Examiner has selectively applied the references to Applicant's claims with Applicant's invention in view. The references would not have been understood by those skilled in the art in the manner that the Examiner has applied the references because the references pertain to different problems reaching different solutions. The Examiner is applying the references as if the solution was the same when, in fact, the solution is different. This is error because it is hindsight.

## CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. 1450, Alexandria, VA 22313-1450.

Signed: *Sally Azevedo*  
Typed Name: Sally Azevedo

Date: March 1, 2004

Respectfully submitted,

*Thomas Schneck*

Thomas Schneck

Reg. No. 24,518

P.O. Box 2-E

San Jose, CA 95109-0005

(408) 297-9733